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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/778,003	02/12/2004	Walter Aldaz	MRKS/0101	4450

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EXAMINER

NEUDER, WILLIAM P

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/778,003	Applicant(s) ALDAZ ET AL.	
	Examiner William P. Neuder	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7,8,10-15,47-52,54-56,80-87,89 and 91-124 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,3,4,7,8,10-15,47,48,80-87,89,91-98,101-107 and 109-124 is/are rejected.
- 7) ☒ Claim(s) 49-52,54-56,99,100 and 108 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/27/04, 8/19/04, 12</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the sealing apparatus being mounted internally of the expandable tubular as set forth in claim 87 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 97 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As written claim 97 is not understood in that it claims a sealing assembly of the sealing assembly of claim 80 used in the sealing assembly of claim 1. Please rewrite claim 97 as an independent claim without referencing other claims.

Also, in the preliminary amendment, the fax copy of claim 124 is unclear. The claim only contains 4 lines and the 4th line is kind of chopped off. Please rewrite claim 124. It has been examined as the 4th line saying, "an annular area defined between the tubular and the sealing element."

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,3,4,7,8,10,11,14,47,48,98,101-104,107,109 and 114 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 22-31 of U.S. Patent No. 6988557. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broader than the claims of 6988557 and are fully encompassed by those claims. For example, claim 1 of the instant application is fully encompassed by claim 1 of 6988557 and it would have been considered obvious to eliminate the self-isolating layer from claim 1 of 6988557.

Claims 12-15,105,106,112-123 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 22-31 of U.S. Patent No. 6988557 in view of Wood et al 6073692. The claims of 6988557 do not specifically set forth the type of medium used or reacting the medium with the fluid to maintain the increased volume. Wood teaches an inflatable seal around an expandable tubular having the specific medium claimed as well as teaching that this medium reacts with the fluid to maintain the increased volume. It would have been considered obvious to use the specific medium material of Wood for the medium material set forth in the claims of 6988557 since both the reference and the claims are directed to inflatable seals using mediums, one would look to Wood to find what kind of material is used as the medium.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,4,7,8,10-15 and 112-124 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al 6073692.

Wood discloses a sealing apparatus and method of operation for use in a wellbore (see figures 1 and 2). AN expandable tubular support 14 is provided. An inflatable seal 24 is mounted externally of the tubular and is designed for radial inflation outwardly into sealing engagement with the wellbore. AS to claim 4, chambers 20 are adapted for inflation. As to claim 7, the chamber 20 is annular and defined by the seal element 24 and the tubular 14. As to claim 8, the chambers are designed to be initially isolated from annulus pressure and fluid in the wellbore. As to claims 10 and 11, filler material 22 is placed in the chambers and maintains the seal element under pressure in sealing engagement with the wellbore. As to claims 12 and 13, the filler material can be a granular solid material and is adapted to react with the fluid to solidify over time (see col. 7, lines 3-12). As to claim 14, seal 24 is inflated by applied fluid pressure. As to claim 15, the fluid reacts with the filler to form a solid. As to method claim 112, the sealing means is ran into the well having a sealing element 24 around tubular 14 and a filler material 22. Fluid is supplied to increase the volume and react with the filler to maintain a portion of the increased volume. As to claim 113, the sealing element is

inflated. As to claim 114, the filler material increases in size when contacted with the fluid. As to claim 115, a viscous mixture is formed when the fluid reacts with the filler. As to claim 116, the filler can be a polymer or clay. As to claim 117, tubular 14 is expanded. As to claim 118, the device is a packer and the packer contains the chambers 20 having the filler medium. As to claims 119 and 120, the fluid supplied to the chambers causes the filler material to swell. As to claims 121-123, the sealing element is maintained in contact with the wellbore and the viscous mixture of the filler and fluid solidifies over time.

Claims 80-85, 89 and 91-96 are rejected under 35 U.S.C. 102(b) as being anticipated by Vick, Jr. 6059038.

Vick discloses a sealing means 38 for sealing a flow port 26 in an expandable tubular 22. Tubular 22 is considered an expandable tubular in as much as all steel tubulars can be expanded to some degree with enough pressure applied. Sealing means 38 is coupled to the tubular at 34. The member is formed from a deformable material and is moveable between the open position (fig. 1B) and the closed position (fig. 2B). As to claim 81, seal means 38 is capable of expansion on expansion of the tubular member. As to claims 82 and 83, the plastically deformable portion is normally urged towards the closed position. As to claims 84 and 85, the deformable portion is moved between closed and open by application of a predetermined fluid pressure. As to claim 89, means 38 is mounted internally of expandable tubing 28. As to claim 91, means 38 has a lower Young's modulus than the tubing 28. As to claims 92 and 93, means 38 is annular and one end 34 is secured to the tubing while the other end

engages the tubing in an interference fit. As to claims 94 and 95, means 38 seals a plurality of circumferential openings as well as axially spaced ports. As to claim 96, the means is in the form of a sleeve.

Claims 80-87 and 91-94 are rejected under 35 U.S.C. 102(b) as being anticipated by Little 1854518.

Little discloses a sealing means 32 for sealing a flow port 31 in an expandable tubular 20. The tubular is considered expandable in that all steel tubulars are expandable to some degree with enough pressure. Means 32 is deformable and coupled to the tubular at one end 23. As to claim 81, sealing means 32 is capable of being expanded. As to claims 82 and 83, the plastically deformable seal 32 is normally urges towards the closed position (fig. 2). As to claims 84 and 85, the seal is moved from the closed to the open (fig. 4) position by application of a predetermined fluid pressure. As to claims 86 and 87, seal 32 is mounted external of the tubing and is attached to the tubing at one end 23. As to claim 91, seal 32 has a lower Young's modulus than tubing 20. As to claims 92 and 93, seal 32 is annular and has one end attached to the tubing and the other end engages the tubing in an interference fit. As to claim 94, seal 32 seals a plurality of ports spaced around the circumference of the tubing (fig. 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 97 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al in view of Vick, Jr. or Little.

In as far as claim 97 is understood, it would have been considered obvious to provide expandable tubing 14 of Woof with sealing members 32 of Little or 38 of Vick to ensure that fluid is delivered to the chambers 20 only once a predetermined fluid pressure has been reached.


Allowable Subject Matter

Claims 49-52,54-56,99,100 and 108 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Neuder whose telephone number is 571-272-7032. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William P Neuder
Primary Examiner
Art Unit 3672

W.P.N.